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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,805	03/28/2006	Youhei Sakamoto	060199	9375
23850                      7590                      12/10/2008 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER				
SHEDRICK, CHARLES TERRELL				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
12/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,805

**Applicant(s)**

SAKAMOTO ET AL.

**Examiner**

CHARLES SHEDRICK

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 8/15/08 have been fully considered but they are not persuasive.
2. Applicant argues that. The reference only speaks to auto-power-on and auto-power-off functions in two places: once in paragraph [0100], and once in figure 8(b), in its discussion of "CLOCK ALARM FUNCTIONS". Further, these descriptions only mention the auto- power-on and auto-power-off functions in passing, and are too vague to understand how these functions would operate or how to properly implement such power features. For example, a person having ordinary skill in the art would not understand what Yamedera et al. powers on or off (e.g., the screen, or the entire device, etc) with its automatic function, and Tagawa et al. does not provide any sort of guidance on this point. In contrast, claims 1 and 11 recite how an auto-power-off unit and an automatic stopping method, respectively, operate, such that one of skill in the art would be able to complete the invention.
3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tagawa et al. teaches a desire to improve mobile phones with non telephone functions such as music data reproduction in order to at least improve device usage with respect

to calling functions. Yamadera et al. teach a pocket telephone and a method aimed to at least improve the functionality of the mobile phone. Yamadera teaches a plurality of non telephone functions including Clock Alarm functions and the Auto Power on Auto Power off feature. One of ordinary skill in the art would have recognized the Auto Power On /Off feature including how the feature works when applied to any element. It is clear to one of ordinary skill in the art according to at least the plain meaning that auto power on/off is the ability to automatically turn on or turn off a particular entity.

4. The Examiner respectfully submits that due to their dependence on claim 1, it is also believed that the combination of Tagawa et al. in view of Yamadera et al. render claims 2-3, and claims 5-10, unpatentable as being obvious.

5. Applicant argues that the office action asserts that Yamedera et al. teaches the further limitations of claim 8 in paragraph [0100]. However, this paragraph only teaches the existence of an alarm unit, but in no way teaches a relationship of the alarm unit to the reset unit as suggested by the office action. In fact, the disclosure of paragraph [0100] does not suggest any attributes of the alarm unit, except that a user may set the alarm from the "CLOCK ALARM FUNCTIONS" selecting function screen (See paragraphs [0099] and [0100]). Thus, Yamedera et al. does not teach resetting the timer to an initial state when the alarm setting has been made. However, the Examiner respectfully disagree. Once the alarm setting has been made to auto power off all functions of the phone cease.

6. The Applicant argues that the office action asserts that the embodiment of claim 9 is obvious by combining the disclosure of Tagawa et al., teaching a unit to automatically stop execution of the non-telephone function, with the disclosure of the alarm unit of Yamedera et al.

However, neither Yamedera et al. nor Tawaga et al. discloses "the alarm setting has been made by the user although the auto-power-off setting has not been made." The Examiner respectfully notes that the argued feature is optional based on the claim language.

For these reasons, claims 2-3 and claims 5-10 are believed to be non-patentable and not in condition for allowance.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Yamedera et al, US Patent Pub. No.: 2002/0123368, hereinafter, "Yamedera".

Consider **claims 1 and 11**, Tagawa teaches a method and a mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function, comprising: a non-telephone unit operable to execute the non-telephone function (e.g., **music reproduction function**)(see at least abstract and at least col. 2 lines 7-10); an unit operable to cause a timer to operate during execution of the non-telephone function (e.g., **the fade out, fade in time, response time, music reproduction time**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1), and automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period (e.g., **based on the fade out, fade in time, response time, music reproduction time**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1); a telephone unit operable to execute the telephone function(e.g., **incoming call as noted in at least the abstract**); and a reset unit operable to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed (e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function**)( see

**at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).**

However, Tagawa does not specifically teach a/an auto-power-off unit.

**In analogous art Yamedera teaches an auto-power off unit (e.g., see at least paragraph 100 and figure 16).**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an auto-power-off unit as taught by Yamedera for the purpose of battery conservation.

**Consider claim 2 and as applied to claim 1, Tagawa as modified by Yamedera teaches wherein the reset unit resets the timer to the initial state at end of a telephone call(e.g., as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function)(see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).**

**Consider claim 3 and as applied to claim 2, Tagawa as modified by Yamedera teaches wherein the telephone unit stops executing the telephone function when receiving a disconnect signal via a telephone line at the end of the telephone call (see cited sections and explanations below with regard to resuming music listening function), and the reset unit resets the timer to the initial state when the execution of the telephone function is stopped by receiving the disconnect signal(e.g., as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function)(see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and**

**figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).**

Consider **claim 5 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the non-telephone unit is started e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).**

Consider **claim 6 and as applied to claim 1**, Tagawa as modified by Yamedera teaches the claimed invention further comprising: an application unit operable to execute an application different from the non-telephone function and the telephone function (**i.e., as noted in the Applicants specs a change of setting or other general functions)(e.g., see key inputs and buttons for various functions)( col. 8 lines 17-60**), wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the application unit is started (**e.g., the timer is reset based on input functions and settings noted in col. 8 lines 17-60**).

Consider **claim 7 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the reset unit resets the timer to the initial state each time a particular key is pressed by a user (**e.g., the stop key resets a listening tracking and the timing thereof)( col. 8 lines 17-60**).

Consider **claim 8 and as applied to claim 1**, Tagawa teaches the claimed invention except further comprising: an alarm unit operable to execute an alarm function in a case when an



alarm setting has been made by a user, wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made.

However, in analogous art, Yamedera teaches an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user (**paragraph 0100**), wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made (i.e., once the phone is off all functions cease)(**paragraph 0100**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an alarm unit as taught by Yamedera for the purpose of battery conservation.

Consider **claim 9** and as applied to **claim 1**, Tagawa teaches the claimed invention except further comprising: wherein a unit automatically stops the execution of the non-telephone function (e.g., based on the fade out, fade in time, response time, music reproduction time)(**see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

However, Tagawa does not specifically teach an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein a unit automatically stops the execution a function (i.e., **any and all functions**) in a case when (i) an auto-power-off setting has been made by the user (e.g., **see paragraph 0100**), or (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an alarm unit as taught by Yamedera for the purpose of battery conservation.

Consider **claim 10 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the non-telephone function is any of a digital camera function, an Internet connecting function, a music play function, a radio function, and a TV function (e.g., see **music production as noted in at least abstract and above noted citations**).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Yamedera et al, US Patent Pub. No.: 2002/0123368, hereinafter, "Yamedera" and further in view of Yoshinaga, US Patent No.: 7,096,045 B2.

Consider **claim 4 and as applied to claim 1**, Tagawa as modified by Yamedera teaches the claimed invention except wherein the reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed.

However, in analogous art, Yoshinaga teaches wherein a reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed (**col. 7 lines 35-55**)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa as modified by Yamedera to include a reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed for the purpose of reducing power consumption as taught by Yoshinaga (**col. 2 lines 15-24**).

#### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617

/Charles Shedrick/ Examiner, Art Unit 2617